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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/667,401

09/23/2003

Gerald Altman

5957-72402

9364

7590

05/28/2008

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EXAMINER

LOVEL, KIMBERLY M

ART UNIT

PAPER NUMBER

2167

MAIL DATE

DELIVERY MODE

05/28/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/667,401	Applicant(s) ALTMAN, GERALD	
	Examiner KIMBERLY LOVEL	Art Unit 2167	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-30, 33, 35-37, 41-45, 48-54 and 56-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-30, 33, 35-37, 41-45, 48-54 and 56-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/21/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to the Amendment filed the 21 January 2008.
2. Claims 24-30, 33, 35-37, 41-45, 48-54 and 56-63 are currently pending and claims 1-23, 31, 32, 34, 38-40, 46, 47, 55 and 64 have been canceled. This action is made Non-Final due to the introduction of rejections under 35 USC 101 and 35 USC 112.
3. The previous prior art rejections of the claims have been withdrawn.

Information Disclosure Statement

4. The information disclosure statement (IDS) submitted on 21 January 2008 was filed after the mailing date of the office action on 22 August 2008. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. **Claims 56-63** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to mention a computer readable memory medium and the computer readable memory medium was not disclosed within the originally filed claims.

7. To allow for compact prosecution, the examiner will apply prior art to these claims as best understood, with the assumption that applicant will amend to overcome the stated 112 rejections.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. **Claims 41-45, 48-54 and 56-63** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

10. **Claims 41 and 48** are directed towards a system. However, it is noted that the use of the word “system” does not inherently mean that the claim is directed towards a machine or article of manufacture. Each unit or means of the claimed system can be

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interpreted as comprising entirely of software *per se* according to one of ordinary skill in the art. Therefore, the claim language fails to provide the necessary hardware required for the claim to fall within the statutory category of an apparatus.

According to MPEP 2106:

The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” Both types of “descriptive material” are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”).

Since **claims 42-45 and 49-54** are dependent on claims 41 and 48 respectively and fail to overcome the deficiencies of claims 41 and 48, the claims are rejected on the same grounds as claims 41 and 48.

11. **Claim 56** is directed towards a computer readable memory medium. The specification fails to provide support for the term “computer readable memory medium.” Therefore, when the term is interpreted by one of ordinary skill in the art, the term can be construed to cover non-statutory embodiments which improperly include network transmission lines (interpreted as wired and wireless transmission), wireless transmission media, signals propagating through space, radio waves, infrared signals, etc.

See, e.g., *In re Nuitjen*, Docket no. 2006-1371 (Fed. Cir. Sept. 20, 2007)(slip. op. at 18) “A transitory, propagating signal like *Nuitjen*'s is not a process, machine, manufacture, or composition of matter.' ... Thus, such a signal cannot be patentable subject matter.”

Therefore, the claimed subject matter fails to fall within one of the four statutory classes.

According to MPEP 2106:

The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” Both types of “descriptive material” are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”).

Since **claims 57-63** are dependent on claim 56 and fails to overcome the deficiencies of claim 56, the claims are rejected on the same grounds as claim 56.

12. To allow for compact prosecution, the examiner will apply prior art to these claims as best understood, with the assumption that applicant will amend to overcome the stated 101 rejections.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. Claims 24, 25, 27, 28, 33, 35, 41-43, 45, 48-52, 56, 57 and 61 are rejected under 35 U.S.C. 102(e) as being anticipated by US PGPub 2005/0125714 to Freeman et al (hereafter Freeman).

Referring to claim 24, Freeman discloses a method, comprising:

receiving a succession of electronic documents into a document management system, wherein each of the succession of electronic documents is received at a corresponding point in time [every document created is stored in a main stream] (see [0032] and [0033]); and

for each of at least a subset of the received electronic documents:

generating a unique time-based identifier [time identification]
corresponding to the point in time at which the electronic document was received
(see [0036]); and

storing the electronic document in a storage system at a storage location
corresponding to the unique time-based identifier for the electronic document
(see [0049])

wherein the electronic document is retrievable from the storage system using its unique time-based identifier (see [0037] and [0058]).

Referring to claim 25, Freeman discloses the method of claim 24, wherein said receiving includes receiving a first electronic document at a first point in time corresponding to a first date and a first time of day within the first date, wherein the unique time-based identifier of the first electronic document corresponds to the first date and the first time of day (see [0034] and Fig 1).

Referring to claim 27, Freeman discloses the method of claim 25, wherein the first time of day is specified by at least an hour value, a minutes value, and a seconds value [i.e., 10:24:59] (see Fig 1).

Referring to claim 28, Freeman discloses the method of claim 24, wherein said receiving includes: receiving imaged electronic documents [scan]; and/or receiving computer generated electronic documents (see [0036]).

Referring to claim 30, Freeman discloses the method of claim 28, wherein the computer generated electronic documents include electronic documents received from one or more of the following sources: word processing programs, graphics programs, e-mail [e-mail], facsimile transmissions (see [0033]).

Referring to claim 33, Freeman discloses the method of claim 24, further comprising: accessing a first electronic document stored in the time-addressable storage system using a first unique time-based identifier, wherein the first unique time-based identifier corresponds to a first point in time when the first electronic document was received into the document management system (see [0058]).

Referring to claim 35, Freeman discloses the method of claim 24, further comprising: generating a record for each of at least a subset of the received electronic documents, wherein each record includes a plurality of attributes [metadata] for the corresponding electronic document (see [0058] and Fig 2).

Referring to claim 41, Freeman discloses a document management system, comprising:

an input unit configured to receive a succession of electronic documents into a document management system, wherein each of the succession of electronic documents is received at a corresponding point in time [every document created is stored in a main stream] (see [0032] and [0033]); and

a storage subsystem to store the succession of electronic documents using corresponding to the unique time-based identifier for the electronic document (see [0049]);

a computer system configured, for each of at least a subset of the received electronic documents, to generate a unique time-based identifier [time identification] corresponding to the point in time at which the electronic document was received into the document management system, and to use the unique time-based identifier to store the electronic document in the addressable storage subsystem (see [0036]); and

wherein the electronic document is retrievable from the storage system using its unique time-based identifier (see [0037] and [0058]).

Referring to claim 42, Freeman discloses the system of claim 41, wherein the input unit is configured to receive a first electronic document at a first point in time

corresponding to a first date and a first time of day within the first date, wherein the unique time-based identifier of the first electronic document corresponds to the first date and the first time of day (see [0034] and Fig 1).

Referring to claim 43, Freeman discloses the system of claim 42, wherein the first time of day is specified by at least an hour value, a minutes value, and a seconds value [i.e., 10:24:59] (see Fig 1).

Referring to claim 45, Freeman discloses the system of claim 42, wherein the first electronic document originated from an electronic document provided as input to the document management system (see [0036]).

Referring to claim 48, Freeman discloses a document management system, comprising:

first means receiving a succession of electronic documents into a document management system, wherein each of the succession of electronic documents is received at a corresponding point in time [every document created is stored in a main stream] (see [0032] and [0033]); and

second means for generating a unique time-based identifier [time identification] corresponding to the point in time at which the electronic document was received (see [0036]); and

third means for storing the electronic document in a storage system at a storage location corresponding to the unique time-based identifier for the electronic document (see [0049])

wherein the electronic document is retrievable from the storage system using its unique time-based identifier (see [0037] and [0058]).

Referring to claim 49, Freeman discloses the document management system of claim 48, wherein a unique time-based address for a given one of a succession of electronic documents corresponds to a date and a time of day within that date that the given electronic document was received into the document management system (see [0058]).

Referring to claim 51, Freeman discloses the document management system of claim 48, wherein the succession of electronic documents include one or more documents, each of which corresponds to an electronic document provided as input to the document management system (see [0036]).

Referring to claim 52, Freeman discloses the document management system of claim 48, further comprising: fourth means for generating a record for each of at least a subset of the received electronic documents, wherein each record includes a plurality of attributes [metadata] for the corresponding electronic document (see [0058] and Fig 1).

Referring to claim 56, Freeman discloses a computer readable memory medium storing program instructions that are computer executable, to:

receive a succession of electronic documents into a document management system, wherein each of the succession of electronic documents is received at a corresponding point in time [every document created is stored in a main stream] (see [0032] and [0033]); and

generate a unique time-based identifier [time identification] for each of at least a subset of the received electronic documents, wherein each unique time-based identifier corresponds to the point in time at which the corresponding electronic document was received (see [0036]); and

store each of the least a subset of the electronic documents in a storage system at a storage system at a corresponding storage location corresponding to the unique time-based identifier for that electronic document (see [0049])

wherein the electronic document is retrievable from the storage system using its unique time-based identifier (see [0037] and [0058]).

Referring to claim 57, Freeman discloses the computer readable memory medium of claim 56, wherein a unique time-based identifier for a first electronic document corresponds to a first-date and a first time of day at which the first electronic document was received into the document management system (see [0058]).

Referring to claim 59, Freeman discloses the computer readable memory medium of claim 57, wherein the first electronic document originated from an electronic document provided as input to the document management system (see [0036]).

Referring to claim 60, Freeman discloses the computer readable memory medium of claim 57, wherein the first time of day is specified by at least an hour value, a minutes value, and a seconds value [i.e., 10:24:59] (see Fig 1).

Referring to claim 61, Freeman discloses the computer readable memory medium of claim 57, wherein the program instructions are further executable to:
generate a record for each of at least a subset of the received electronic documents,

wherein each record includes a plurality of attributes for the corresponding electronic document (see [0058] and Fig 1).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 26, 29, 36, 37, 44, 50, 53, 58-60, 62 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over US PGPub 2005/0125714 to Freeman et al as applied to claims 25, 28, 35, 42, 57 and 61 above, and further in view of US Patent No 6,192,165 to Irons (hereafter Irons).

Referring to claim 26, Freeman fails to explicitly disclose the further limitation wherein the first point in time corresponds to a time when the first electronic document was created by imaging a physical document. Irons discloses creating an electronic file system wherein the documents are identified by timestamps (see abstract), wherein the first point in time corresponds to a time when the first electronic document was created by imaging a physical document (see column 7, lines 10-24).

It would have been obvious to one of ordinary skill in the art at the time of the invention to receive the electronic documents of Freeman by scanning physical documents as disclosed by Irons. One would have been motivated to do so in order to

create an environment in which documents can be readily shared across a network (Irons: see column 1, lines 24-52).

Referring to claim 29, Freeman fails to explicitly disclose the further limitation wherein the imaged electronic documents include electronic documents that were created by imaging physical documents. Irons discloses creating an electronic file system wherein the documents are identified by timestamps (see abstract), wherein the imaged electronic documents include electronic documents that were created by imaging physical documents (see column 7, lines 10-24).

It would have been obvious to one of ordinary skill in the art at the time of the invention to receive the electronic documents of Freeman by scanning physical documents as disclosed by Irons. One would have been motivated to do so in order to create an environment in which documents can be readily shared across a network (Irons: see column 1, lines 24-52).

Referring to claim 36, 53 and 62, Freeman fails to disclose the further limitation of for each of at least a subset of the received electronic documents, updating one or more tables in a database to include references to the corresponding generated record. Irons discloses creating an electronic file system wherein the documents are identified by timestamps (see abstract), further comprising the further limitation of for each of at least a subset of the received electronic documents, updating one or more tables in a database to include references to the corresponding generated record (see column 17, lines 7-32).

It would have been obvious to track the files of Freeman in the tables disclosed by Irons. One would have been motivated to do so in order to create an environment in which documents can be readily shared across a network (Irons: see column 1, lines 24-52).

Referring to claim 37, 54 and 63, the combination of Freeman and Irons discloses the method of claim 36, wherein each of the tables is searchable using one or more attributes [metadata] (Irons: see column 17, lines 7-32).

Referring to claims 44, 50 and 58, Freeman fails to explicitly disclose the further limitation wherein the first electronic document originated from a first physical document converted into the first electronic document. Irons discloses creating an electronic file system wherein the documents are identified by timestamps, wherein the first electronic document originated from a first physical document converted into the first electronic document (see column 7, lines 10-24).

It would have been obvious to one of ordinary skill in the art at the time of the invention to receive the electronic documents of Freeman by scanning physical documents as disclosed by Irons. One would have been motivated to do so in order to create an environment in which documents can be readily shared across a network (Irons: see column 1, lines 24-52).

Response to Arguments

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17. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KIMBERLY LOVEL whose telephone number is (571)272-2750. The examiner can normally be reached on 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cottingham can be reached on (571) 272-7079. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John R. Cottingham/
Supervisory Patent Examiner, Art Unit 2167

Kimberly Lovel
Examiner
Art Unit 2167

23 May 2008
kml